<div align="center">REMARKS/ARGUMENTS</div>

Claims 1-29 are currently pending in the present application. Claims 30-36 have been canceled. The Examiner has rejected claims 19-29 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Examiner has rejected claims 1-29 under 35 U.S.C. § 103(a) as allegedly being unpatentable over PCT Appl. Publ. No. WO 01/16804 A2 to Chandhok et al. in view of U.S. Patent No. 6,026,410 to Allen et al. Applicant respectfully requests reconsideration of the present application.

<div align="center">**Claims 19-29 Define Statutory Subject Matter**</div>

Claim 19 has been amended to address the Examiner's rejection under 35 U.S.C. § 101. Claim 29 has been amended; however, not in a manner directed to the instant rejection, since nothing more is required to satisfy the requirements of 35 U.S.C. § 101. Specifically, the language of claim 19 has been amended to include "computer-readable data storage medium comprising executable instructions operative, when executed, to cause one or more processors to perform a method for facilitating collaborative updating of a file." The foregoing amendment is sufficient to comply with the MPEP and governing Federal Circuit case law. Furthermore, claims 19 and 29 further define patentable subject matter as they are limited to a practical application—namely, the collaborative updating of files among users.

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Claims 1-29 are Allowable over Chandhok and Allen

A. **The Proposed Combination Fails to Disclose, Teach, or Suggest Limitations Recited in the Independent Claims**

To establish a prima facie case of obviousness, "the prior art must teach or suggest all the claim limitations." MPEP § 2143; see also MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

As to the claimed subject matter, the Examiner relies on the combination of Chandhok and Allen. However, the cited prior art, neither individually nor in combination, discloses the claimed subject matter.

The claimed subject matter is directed to facilitating the collaborative update process by receiving and providing data sets including delta data, which indicate the difference between a current version and a preceding version, to intended recipients that accessed the preceding version. Claims 1, 19 and 29 also state that the delta data is for constructing the current version of the file from the preceding version of the file. The use of delta data, as opposed to transmitting the entire updated version of the file, results in certain advantages, such as reduced bandwidth requirements.

The proposed combination of Chandhok and Allen fails to disclose or suggest the claimed subject matter. As the Examiner admits, Chandhok teaches a system that does not provide delta data to recipients who have previously accessed a preceding version of a file. Rather, Chandhok discloses a system where the entire new version of a file is transmitted to recipients, regardless of whether they have accessed a preceding version of the file. The use of hash functions and the like in Chandhok is directed to verifying

correspondence between an existing version and a new version of a file, before the new version replaces the old version of the file. See Chandhok at page 8, lines 18-33.

The Examiner relies on Allen, alleging that it teaches the use of delta files. The teachings of Allen, however, do not support the Examiner's allegations. Specifically, Allen fails to teach the use of delta data as disclosed and claimed—namely, "delta data indicating the difference between the updated version of the file and an immediately previous version of the file for constructing the updated version of the file from the immediately previous version of the file." Rather, Allen teaches a collaboration tool for processing and relaying notes and action requests in computer systems. The system taught by Allen receives a natural language expression, parses it to identify keywords, and locates one or more information objects based on the identified keywords. See Allen, Col. 2, line 59 to Col. 3, line 6; Col. 5, lines 25-31; Col. 8, lines 22-45. Information objects can correspond to projects, contacts, lists, and the like. See Figure 15. The information objects are used to create structured information output. Allen also teaches that the parser supports "collaboration parsing"—that is, it recognizes terms in the natural language expression that suggest a collaborative interaction between two users, see Allen, Col. 21, lines 32-60; Col. 24, lines 46-61, with a recognized contact being addressed being designated a "delegate."

According to the "Collaboration Cycle" taught by Allen, a natural language expression is parsed to detect an action request. See Allen, Col. 28, lines 14-19. The parser also links in other objects, such as contacts, to formulate an action request that includes a header with various fields. See Allen, Col. 28, lines 35-42. When completed by the initiator, the action request, which may be an ASCII text message (Col. 29, lines 16-32), is sent to the delegate. Allen, Col. 28, lines 62-66. Upon sending the action

request, the computing system files it. See Allen, Col. 29, lines 33-45.

Generally speaking, the action request, according to Allen, requires a response. See Allen, Col. 24, lines 46-47. When a reply is received, the action request is updated and refilled. See, e.g., Allen, Col. 29, lines 63-67. The reply, however, is simply a message that indicates acceptance, rejection, or some other information related to the original action request. The reply is not a message that contains the difference between a current version of a file and a previously accessed version. The passage cited by the Examiner in the Office Action (Allen, Col. 30, line 54 to Col. 31, line 30) simply discloses the collaborative messaging process from the point of view of the delegate. See Allen, Col. 30, lines 23-24. For example, when the action request is received and displayed, the delegate is prompted to respond. See Allen, Col. 31, line 1-7. The reply interface allows the user to select from a set of predetermined choices: "Yes, Yes if, No, Comment and Done." Allen, Col. 31, line 10. Completion of the reply workflow, however, merely results in a responsive message being transmitted back to the initiator, and updates to various objects such as calendars, projects, and the like.. See Allen, Col. 31, lines 50-63. However, as discussed above, the reply is merely a message, but does not indicate a difference between "the updated version of the file and an immediately previous version of the file for constructing the current version of the file from the preceding version of the file," per the language of the pending claims.

In attempting to support the rejection, the Examiner makes several unsupportable and unfounded allegations. For example, the Examiner states that the cited passage "suggest [sic] the recipient [is] able to change or update the project and send it back the originator or forward it to the new delegate." This contention is not supported by the reference. As discussed above, the action request and reply sequence

discussed above merely includes a series of messages relating to a project or other object. While the messages may cause updates to one or more related objects, the messages themselves do not encode the difference between a first version of a file and a second version of a file. Furthermore, Allan does not disclose that that the reply includes delta data for "constructing the updated version of the file from the immediately previous version of the file." The Examiner also alleges that "upon receiving the message the recipient [is] able to see the recent work perform [sic] by other delegate [sic] which is the delta file." Office Action at 7. Again, this contention is unsupportable. First off, the Examiner points to no teaching of Allen wherein "the recipient is able to see the recent work performed by other delegate [sic]." Secondly, Allen does not teach delta files that encode the differences between a first version of a file and a second version of the file for constructing the updated version of the file from the immediately previous version of the file.

Furthermore, the Examiner's reasoning in the Advisory Action mailed January 23, 2007 essentially admits that Allen fails to disclose "delta data indicating the difference between the updated version of the file and an immediately previous version of the file for constructing the updated version of the file from the immediately previous version of the file." As the Examiner admits, in Allen, various recipients of a message or file may simply modify the message and transmit it to other users. While the message is certainly an "updated version of the message" it does not include delta data for constructing an updated version of a file from a previous version.

Based on the foregoing, it is clear that Allen fails to teach delta data as disclosed and claimed.

B.   The Examiner has Failed to Properly Establish a Prima Facie Case of Obviousness With Respect to the Proposed Combination

Based on the foregoing, it is clear that the Examiner has failed to set forth a combination that discloses the claimed subject matter as required by the M.P.E.P. and governing Federal Circuit case law. Applicants also respectfully submit that the rejection of claims 1-29 based on the proposed Chandhok-Allen combination is improper because the Examiner has not shown the required teaching, suggestion, or motivation in Chandhok, Allen, or in the knowledge that was generally available to those of ordinary skill in the art at the time of the invention to combine Chandhok and Allen with each other as proposed.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a prima facie case of obviousness based on modification or combination of prior art references. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. See Id. (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references can be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. See Id. (citations omitted). Moreover, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

Applicants respectfully submit that the rejection of claims 1-29 based on the proposed Chandhok-Allen combination is improper, under the M.P.E.P. and governing Federal Circuit cases. In fact, nowhere does the Examiner demonstrate, with respect to the proposed combination, that Chandhok, Allen, or knowledge generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching, suggestion, or motivation whatsoever to make the proposed combination. As an example, the Examiner merely states that one would have been motivated to

combine Chandhok and Allen "in order to allow the each [sic] distribute [sic] user to complete their task as assign [sic] in the project."   Office Action at 7.

This alleged motivation, however, is woefully insufficient to meet the strict requirements of the M.P.E.P. and governing Federal Circuit case law. Rather, the Examiner has engaged in impermissible hindsight prohibited by the MPEP. For example, nowhere does the Examiner point to any teachings in the prior art that provides a motivation to combine Chandhok and Allen as proposed. Here, the Examiner points to nothing that suggests the desirability or provides a motivation to combine Chandhok and Allen to achieve the claimed subject matter. Furthermore, this alleged motivation strays from the motivation behind the invention, which is the use of delta data to conserve bandwidth and other network resources. Of course, this is not surprising, since Allen does not teach delta data that indicate the difference between a first version of a file and a second version of a file.

For at least these reasons, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness against claims 1-29. Applicants respectfully request reconsideration and allowance of claims 1-29.

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In light of the foregoing, Applicant believes that all currently pending claims are presently in condition for allowance. Applicant respectfully requests a timely Notice of

Allowance be issued in this case. If the Examiner believes that any further action by Applicant is necessary to place this application in condition for allowance, Applicants request a telephone conference with the undersigned at the telephone number set forth below.

Date: April 18, 2007

Customer Number: 30505
Law Office of Mark J. Spolyar
2200 Cesar Chavez St., Ste. 8
San Francisco, CA 94124
415-826-7966
415-480-1780 fax

Respectfully Submitted,
LAW OFFICE OF MARK J. SPOLYAR
By

/Mark J. Spolyar/
Mark J. Spolyar
Reg. No. 42,164